

**IN THE UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA – WESTERN DIVISION**

V.

NOW COMES the Plaintiff, Intuitive Imaging Informatics, LLC, by and through counsel, and hereby replies in support of its **Motion for Leave to File Its First Amended Complaint** [D.E. #68].

1       **I. FACTUAL BACKGROUND.**

2           The Defendants’ attempt to make Plaintiff out as the “bad guy” in this matter  
3 is disgraceful. Plaintiff is not the global behemoth seeking to take something that  
4 doesn’t belong to it from a much smaller business—that is the Defendants.  
5 Plaintiff did not brazenly expand its use of a trademark to new goods and services  
6 with full knowledge that it is owned and registered by another—that too is the  
7 Defendants. Plaintiff did not hire a private investigator to pretend to be a potential  
8 customer of a trademark owner, covertly seeking evidence of imagined  
9 abandonment—that, too, is the Defendants. And finally, Plaintiff is not the one  
10 seeking to evade liability for such actions by playing a corporate shell game. *See*  
11 D.E. #71, pp. 8-12 of 28. That’s the Defendants too.

12           The U.S. Trademark Office impeded Defendants’ bulldozing of Plaintiff’s  
13 rights by pointing out that their trademarks are likely to be confused with  
14 Plaintiff’s. Rather than face this reality, Defendants filed a frivolous abandonment  
15 proceeding at the TTAB. Even after Plaintiff produced hundreds of documents  
16 proving continued use, and testified openly about past and intended future use, the  
17 Defendants still (dissonantly) cling to the abandonment defense. *See* D.E. #66-1,  
18 pp. 2-278.

19           The Defendants’ complaints about the events leading up to the filing of the  
20 instant motion are pure make-believe. Yes, Plaintiff requested a continuance of the  
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1 MJOP hearing date for a long-planned family vacation. When the hearing date  
2 moved, so did the briefing deadlines. That is by local rule, not by some trickery.  
3 *See* L.R. 7-11. At no time did Defendants request that the deadlines remain static,  
4 and the stipulation they signed was crystal clear. D.E. #63.

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6 Moreover, there is nothing at all deficient in Plaintiff's pre-filing meet and  
7 confer. On July 19<sup>th</sup>—fully **ten days** prior to seeking leave to amend—Plaintiff  
8 informed defense counsel that it intended to seek leave to “*file an amended*  
9 *complaint adding a claim for relief for reverse confusion, and also adding Orpheus*  
10 *Medical as a defendant.*” D.E. #71-2, p. 7 of 7. And that is precisely what  
11 Plaintiff did. Nothing in the local rules requires Plaintiff to provide a proposed  
12 amended complaint, but Plaintiff nevertheless did so as soon as it was complete;  
13 then, Plaintiff satisfied counsel's ensuing requests to supply it in various additional  
14 forms. Fully cognizant that July 29<sup>th</sup> was Plaintiff's deadline to file the motion  
15 [D.E. #60] (and hoping that the Plaintiff would miss it) Defendants did not consent  
16 to the amendment. And, Plaintiff indulged counsel's request for a *second* meet-  
17 and-confer by Zoom, post-filing, which of course resulted in no change.  
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22 And, there is no chicanery in Plaintiff's effort to streamline the issues before  
23 the Court by suggesting a stipulation to file the amended complaint and a re-filing  
24 of the MJOP as to the amended complaint. To the contrary, this is precisely what  
25 litigants are supposed to do—assist the Court in streamlining its docket.  
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## 1 II. ARGUMENT.

### 2 a. The Proposed Amendments Are Not Futile.

3 Prior to filing this motion, Plaintiff informed Defendants that it believes the  
4 MJOP lacks merit, and that the proposed amendment is not an effort to rectify the  
5 perceived deficiencies in the original Complaint. Plaintiff also shared its view that  
6 the Amended Complaint nevertheless moots the MJOP because the MJOP is  
7 directed to the original Complaint, which will no longer be operative should leave  
8 be granted. The Court has issued no ruling that there is anything wrong with the  
9 Complaint; but if the Court does ultimately find merit in the MJOP, the mere  
10 seeking of leave to amend (to add parties and a cause of action) is no basis to  
11 conclude that whatever deficiencies exist are incurable. As such, Plaintiff's  
12 futility argument must fail.

13 There is no basis for the Defendants' claim that Plaintiff knew, or should  
14 have known, about Orpheus Medical prior to filing the Complaint. As explained in  
15 Plaintiff's opposition to the MJOP [D.E. #71, pp. 8-12 of 28], Plaintiff has been  
16 left to its own devices to determine which of the Intuitive Surgical entities is  
17 engaging in infringing activity. The Defendants are the sole party in possession of  
18 such facts, and they refused to answer Plaintiff's on-point discovery requests.  
19 Instead, they hide smugly behind a corporate shell game in which the relationships  
20 between their "dozens" of corporate entities are "not publicly known." D.E. #48,  
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1 p. 7. This is precisely why Plaintiff named “DOES 1-10” as defendants in the  
2 original Complaint; so that these Does can be identified when they are known.

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4 Contrary to Defendants’ claim, Plaintiff certainly did explain during the  
5 parties’ second meet-and-confer that it is now aware of specific facts regarding  
6 Orpheus’s involvement in the infringements. Defense counsel was informed that  
7 Orpheus is now referred to as “ORPHEUS – AN INTUITIVE COMPANY” and  
8 that it is offering goods and services intolerably close to Plaintiff’s goods. Counsel  
9 was likewise apprised of the contents of the Orpheus website. *See* D.E. #71-6.  
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12 The Defendants point to nothing—no document, no fact, nothing—to  
13 support their averment that the Plaintiff knew or should have known about  
14 Orpheus Medical’s involvement in the infringing activities for so long that laches  
15 should bar Plaintiff’s claims against them. The Orpheus Medical entities do not  
16 have the term “intuitive” in their corporate names, nor anything that makes  
17 reference to imaging. Their acquisition by Intuitive Surgical, in and of itself, sheds  
18 no light whatsoever on the question of what trademarks Orpheus Medical uses, or  
19 would use, to offer its goods and services.  
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23 **b. The Addition of a Reverse Confusion Claim Is a Significant and**  
24 **Necessary Change.**

25 The addition of a specific claim for “reverse confusion” is significant and  
26 necessary. The Ninth Circuit has held that “reverse confusion...is a theory of likely  
27 confusion that may be alleged by itself or in addition to forward confusion.”  
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1 *Marketquest Grp., Inc. v. BIC Corp.*, 862 F.3d 927, 932 (9<sup>th</sup> Cir. 2017). Whether  
 2 it is pleaded separately or not, reverse confusion may be relied upon only when it  
 3 is “compatible with the theory of infringement alleged in the complaint.” *Id.* In  
 4 other words, even though a claim for reverse confusion need not be separately  
 5 pleaded, “the allegations will vary in individual cases” and the overall allegations  
 6 of a complaint must to be compatible with a reverse confusion theory. *Id.* It does  
 7 not just magically arise in every complaint for trademark infringement.  
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10 Here, the proposed Amended Complaint adds allegations that eliminate any  
 11 doubt that reliance on a reverse confusion theory is appropriate under the facts of  
 12 this case. *See* D.E. 68-1 ¶¶45-47. Plaintiff has therefore exercised its option to  
 13 plead reverse confusion expressly, and separately. Defense counsel has stated that  
 14 it “has always understood [Plaintiff’s] Lanham Act claim to include reverse  
 15 confusion”; therefore they will suffer no prejudice by adding the claim specifically.  
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 19 *See Saadi Decl.*, Exh. A.

### 20 III. CONCLUSION.

21 For the foregoing reasons, **Plaintiff’s Motion for Leave to File Its First**  
 22 **Amended Complaint** [D.E. #68] should be granted.  
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24 DATED: August 11, 2024.

**EDWARD T. SAADI, LLC**

25 By: /s/ Edward T. Saadi.  
 26 Edward T. Saadi, Esq.  
 27 *Attorney for Plaintiff Intuitive Imaging*  
 28 *Informatics, LLC*